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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,341	07/06/2005	Miroslav Veverka	262999US0PCT	3636
22850 7590 04/25/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
CHANG, CELIA C				
ART UNIT		PAPER NUMBER		
1625				
NOTIFICATION DATE		DELIVERY MODE		
04/25/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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**Office Action Summary****Application No.**

10/525,341

**Applicant(s)**

VEVERKA ET AL.

**Examiner**

Celia Chang

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/08)  
Paper No(s)/Mail Date 2/22/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This application is a 371 of PCT/CZ2003/000049.

A claim to the priority benefit was made but no certified translation of the priority document was submitted. Therefore, the filing date for the instant application is Aug. 28, 2003, i.e. the PCT filing date.

Claims 1-7 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent,

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being clearly anticipate by Bardore et al. US 4,847,265 or claim 7 is rejected under 35 U.S.C. 102(a) as being clearly anticipate by Bousquet et al. US 6,429,210.

See '265 col. 6, example 1(e) crystalline form with m.p. 184°C (lines 47-64); see '210, col. 9, example 1B with m.p. 184±0.3 °C.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardore et al. US 4,847,265 or Bousquet et al. US 6,429,210 in view of Lifshitz-Liron et al. US 7,074,928 supplemented with Mukarram et al. WO 2005/012300 (US 7,291,735).

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Bardore et al. '265 or Bousquet et al. '210 disclosed process of making the same claimed product which has a m.p. of 184°C, see '265 col. 6, example 1(e) lines 47-64, or '210 col. 9, lines 44-60, example 1B.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between the instant claims and the prior art process is that instead of acetone, the instant claims employed alcohol, esters or mixture thereof. Lifshitz-Liron et al. US 7,074,928 taught that variation of solvent such as ether may be employed to obtain the same product (col. 19-20 examples of form I). Mukarram et al. '300 taught that the same product obtained with acetone can be obtained using solvents such as alcohol or ether (see p.2, paragraph after structural formula).

*Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)*

One having ordinary skill in the art would be motivated to employ variation of solvents in obtaining the same product because one has been suggested that similar organic solvent would give the same product as evidenced by the per ponderous of references i.e. '265, '210, '928 and '300, that changing solvents is a routine choice by the person having ordinary skill and lower alkanoyl-lower alcohol esters are common laboratory solvents.

3. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Process of making polymorphic forms of a defined compound is very specific and unpredictable. The state of the art of polymorph recovery is highly unpredictable. See for example *Kirk-Othmer Encyclopedia of Chemical Technology* Copyright © 2002 by John Wiley & Sons, Inc., pp. 95-147, Article Online Posting Date: August 16, 2002. This article indicates that many uncertain factors determine morphology, and specifically that the appearance of the crystalline product and its processing characteristics (such as washing and filtration) are affected by crystal habit (i.e., the general shape of a crystal). Relative growth rates of the faces of a crystal determine its shape. Faster growing faces become smaller than slower growing faces and,

in the extreme case, may disappear from the crystal altogether. Growth rates depend on the presence of impurities, rates of cooling, temperature, solvent, mixing, and supersaturation. Furthermore, the importance of each of these factors may vary from one crystal face to another, see page 114.

The reference also teaches that polymorphism is a condition wherein crystalline form is intimately associated with processing ("*Polymorphism* is a condition in which chemically identical substances may crystallize into different forms. Each form is, however, only stable (thermodynamically) in a certain range of temperature and pressure. In the case of ambient pressure, eg, ammonium nitrate exhibits four changes in form between -18 and 125°C:

liquid  $\xleftarrow{160.6^{\circ}\text{C}}$  cubic  $\xleftarrow{125.2^{\circ}\text{C}}$  trigonal  $\xleftarrow{84.2^{\circ}\text{C}}$  orthorhombic I  $\xleftarrow{32.3^{\circ}\text{C}}$  orthorhombic II  $\xleftarrow{-18^{\circ}\text{C}}$  tetra

Transitions from one polymorphic form to another may be accompanied by changes in process conditions (temperature, pressure, shear or solution composition), transitions from one polymorphic form to another and lead to formation of a solid product with unacceptable properties (eg, melting point or dissolution rate).

The Mukarram et al. WO 2005/012300 reference provided evidence that the instant claimed process is inoperable in producing form I exclusively (see '300 p.3 paragraphs after structural formula). Specifically, Mukarram '300 disclosed that form I without contamination of other forms would have a higher melting point between 198-200°C. All the examples made from the instantly claimed process being evidence in the specification have melting points of 184-186°C, thus, are inoperable for making exclusively form I.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*OACS/Chang*  
*Apr. 21, 2008*

*/Celia Chang/*  
*Primary Examiner*  
*Art Unit 1625*